

REMARKS/ARGUMENTS

Claims 1-36 remain pending in the application. Claims 1-36 are rejected. As explained in more detail below, the Applicants submit that all claims are now in condition for allowance and respectfully request such action.

Rejections under 35 U.S.C. §103

Claims 1-2, 4-5, 7-9, 15-19, 21-22, 24-26 and 32-36 are rejected under 35 U.S.C. §103(a) as being anticipated by Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543). The Applicants request reconsideration in view of the Remarks below.

During the Interview conducted May 16, 2006, “Examiner Tran indicated that a limitation that more clearly indicates the transmitting of the caller identification occurs before attempted communication between the first and the second user would differentiate the pending claims from Emerson”. (Applicants’ Interview Summary dated May 17, 2006) As such, Applicants subsequently amended the claims to recite:

transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database

(Claims 1, 18, 35 and 36; amendments emphasized). This is distinctly different since Emerson requires communication between two parties to be initiated or established before transmitting identification information. For example, paragraphs 0039 and 0040 of Emerson set forth the transmission of profile information in a canned message to be transmitted, for example, as combined with E-card, in which the E-card “can be sent to the called system during call setup”. (Paragraph 0040; emphasis added). Indeed, transmitting profile information is performed in the context of initiating contact, such as a call, with another user. (See also paragraph 0035; stating “user profile information is sent to and exchanged with corresponding systems in the call setup process, particularly in the circumstance of a failed call setup attempt due the called party not answering”; emphasis added); and paragraph 42 (the E-card may alternatively be “passed to the other party on demand after call setup”). Further, there is no teaching in Emerson of transmitting the first user’s selected caller identification “to a list of contacts selected from the first user’s

contact database". As discussed above, Emerson shows the transmitting of information to a called party. There is no teaching to transmitting the identification to a list of contacts, but rather only to the called party.

In view of the Applicant's arguments and amendments, the Office Action dated July 26, 2006 now acknowledges that Emerson does not suggest transmitting, upon selection of the caller identification and before initiating communication with a second user. (page 2) The Office Action, however, now asserts "Lautenschlager teaches a method and device for call identification that enable the user to select the identification data and transmitting to the destination user before communication is established". (pages 2-3)

The Applicants respectfully submit that Lautenschlager is improperly being applied to the rejected claims. First, as acknowledged in the Office Action, the claims recite transmitting the caller identification, "upon selection of the caller identification and before initiating communication with a second user". This is distinctly different than **established** communication. Second, Lautenschlager clearly discloses transmitting the caller identification in the context of a call setup process, as disclosed by Emerson. As expressly stated in Lautenschlager:

The object of the present invention, therefore, is to create a convenient identification of the call of a subscriber calling, via a telecommunication network, a destination telecommunication device of a called subscriber.

(Col. 1, ll. 47-50; emphasis added) This is further apparent within the sections of Lautenschlager cited by the Office Action.

This invention is based on the concept that the destination telecommunication device, in particular, a destination terminal, receives the identification data within a call setup signalling message and outputs this or, if applicable, output data generated from it, as acoustic and/or visual and/or mechanical call signals instead of an acoustic call tone selected by the destination telecommunication device. Instead of the called subscriber hearing an arbitrary ringing tone or a call melody which, although they may each be specifically set on the called subscriber's terminal, nevertheless do not contain any indication of the source of the call, the incoming call is signalled through individual and personal signals which are assigned to the caller and are selected by the latter.

(Col. 1, ll. 53-67; emphasis added) As also disclosed in Emerson, the call setup message of Lautenschlager takes place in the context of a call (i.e. after initiation of communication).

The identification data for call identification can be transmitted directly from the source telecommunication device of the caller to the destination telecommunication device of the called subscriber, for example, in a call setup message.

(Col. 2, ll. 23-26; emphasis added)

Moreover, neither Emerson nor Lautenschlager teach the transmitting of the first user's selected caller identification "to at least one contact from a list of contacts selected from the first user's contact database". The Office Action dated July 27, 2006, asserts this step is met by paragraphs 0039 and 0040. Those sections, however, merely disclose the creation of an E-card comprising information of the calling party for transmittal to a called party. "[A]n E-card acts like an 'enhanced Caller-ID', providing the called party with expanded information about the caller." (Page 5, para. 0040, ll. 4-6) Thus, the database disclosed in the cited portion of Emerson comprises the user's own information that may be combined to make an E-card which then may be transmitted to a called party, it is not the first user's database that comprises a list of contacts for transmitting the identification to. Furthermore, paragraphs 0043 and 0044 merely allow either a called or calling party to store the other's E-card. As expressly set forth in paragraph 0043 "[i]n this fashion, the calling party's E-card is associated with a call, and is transferred from phone to phone along with the call".

Therefore, for at least these reasons, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 3 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Awada et al. (6,873,861).

As discussed in detail above, neither Emerson nor Lautenschlager discloses or otherwise suggests at least "transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user's contact database". This limitation is not met or otherwise

suggested by Awada, which is directed towards transmitting business cards during a phone call. Moreover, claims 3 and 20 further limit the element “selecting, by a first user, a caller identification associated with an identity of the first user” as recited in the claims. In contrast, the cited text of Awada concerns the transmission after a business card has already selected and stored. For at least these reasons, combining Emerson with Awada does not suggest the subject matter of the rejected claims. The Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection.

Claims 6 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Morkel (US 2002/0052921).

In response, the Applicant submits the rejected claims are not obvious in view of the cited references. As discussed in detail above, neither Emerson nor Lautenschlager discloses or otherwise suggests at least “transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Morkel. The Office Action asserts that Morkel teaches transmitting the Caller ID to the list of contacts (page 1, para. 0007, page 2, para. 0011, and page 3, para. 0035) for the purpose of securely acquiring, handling, and maintaining contact information (page 1, para. 0002 and 0006). The cited paragraphs do not read upon the rejected claims. For example, claim 6 recites:

The method of claim 1, wherein the step of transmitting, upon selection, the caller identification to a list of contacts selected from the first user’s contact database further comprises:

transmitting the caller identification to the list of contacts through a background transmission process.

In contrast, the cited text of Morkel sets forth that a user can attach a message to an email directed to a recipient indicating that personal information is included in the message (para. 7, 11, and 35). Therefore combining Emerson with Morkel does not suggest the subject matter of the rejected claims, therefore, for at least these reasons the Applicant respectfully requests

reconsideration and withdrawal of the rejection. In the alternative, the Applicant requests clarification on where Morkel teaches such a background transmission process and how one skilled in the art would have been motivated to make such a combination.

Claims 10 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Beaton et al. (6,442,263).

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, neither Emerson nor Lautenschlager discloses or otherwise suggests at least “transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Beaton.

Therefore combining Emerson with Beaton does not suggest the subject matter of the rejected claims, therefore, in view of the foregoing, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 11-14 and 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Emerson, III (US 2003/0043974) in view of Lautenschlager et al (6,970,543) and further in view of Toyryla et al. (US 2003/0083086).

In response, the Applicant submits the rejected claims are not obvious in view of the cited references as the teaching, motivation, or suggestion to make the claimed combination. As discussed in detail above, neither Emerson nor Lautenschlager discloses or otherwise suggests at least “transmitting, upon selection of the caller identification and before initiating communication with a second user, the caller identification to at least one contact from a list of contacts selected from the first user’s contact database”. This limitation is not met or otherwise suggested by Toyryla. Indeed, the cited text merely states that groups “may be created and managed by sending standard messages, i.e. in a way similar to distributing electronic business

cards (and ringtones and logos)." (Page 3, para. 0042). Merely teaching that groups may be created by sending standard messages does not teach or otherwise suggest the subject matter of the rejected claims. Therefore, the Applicant respectfully requests reconsideration and withdrawal of the rejection.

CONCLUSION


It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,
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